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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,950	12/06/2000	Michiteru Kodama	826.1640/JDH	6943

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EXAMINER

KYLE, CHARLES R

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/729,950

Applicant(s)

KODAMA ET AL.

Examiner

Charles Kyle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-8, 10, 11 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-8, 10, 11 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claims 15 and 16 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 15 claims a discounted trade price calculated based on total or average trade amounts for a past specific period; this language does not further limit this concept already recited in Claim 14 because Claim 14 also recites a discounted trade price if a total or average trade amount... for a past specific period. Both Claims recite a discounted price related to total or average trade amounts for a past specific period. In Remarks, Applicant argues that claim 15 recites “how” to calculate a discount but does not identify any further limiting calculation method. Claim 15 recites only that the calculation is *based on* total or average trade amounts of the past period; These limitations are effectively recited in Claim 14.

Claim 16 claims that a trade amount considered in discounting is for a past specific period, a concept already recited in Claim 14. Applicant provides no refutation of this observation that Claims 14 and 16 both recite these similar limitations, and no more.

Claim Rejections - 35 USC § 112

Rejections of Claims 1-3, 6-8 and 10-11 and 13 of the prior office action are withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6-8 and 10-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,842,178 *Giovannoli* in view of US 6,317,727 *May* and further in view of US 6,598,027 *Breen, Jr. et al.*

As to Claim 1, *Giovannoli* discloses the invention substantially as claimed, including in an electronic purchase system for providing a site where a sellers and a plurality of purchasers participate (Abstract), elements of:

a storage unit storing sales-related information about a commodity that the seller offers (Fig. 4, "Product Database"; Col. 4, lines 43-52);

a purchaser registration unit registering one or more purchasers of the plurality of purchasers (Fig. 3, second box ; Col. 4, lines 53-63) and a permission flag indicating, for each of the purchasers, whether the seller permits a trade therewith (Col. 7, lines 35-52); and

a publication unit making public the sales-related information to purchasers registered by said purchaser registration unit (Fig. 4., "Central Office"; Fig. 3, second box; Col. 6, line 64 to Col. 7, line 2).

In the treatment of this Claim and those below, “registration” is understood as the process disclosed by *Giovannoli* of filter specification by purchasers or sellers to select appropriate trading counter parties. Additionally, the receipt by the RFQ network of user e-mail addresses as disclosed by *Giovannoli* would constitute registration. Additionally, a flag is read as a binary choice to perform an action or not.

Giovannoli does not specifically disclose the new limitations whereby sales-related information goes to a purchaser with a flag set to indicate trading, or a management unit recording trade amounts and updating a flag to reject trades when the trade amount for a past period meets at least one criterion. *May* discloses the first new limitation at Col. 45, line 46 to Col. 46, line 13 and the second new limitation at Col. 23, line 1 to Col. 24, line 44, particularly Col. 23, lines 9-14. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Giovannoli* with the new limitations disclosed by *May* because this would facilitate matching of suitable trading partners as shown by *May* at Background and Summary of the Invention.

Giovannoli does not disclose the new limitation wherein trade with a customer is refused based on purchases lower than a threshold. *Breen, Jr.* discloses this limitation at Fig. 14A, ele. 1102g and Col. 17, lines 29-42. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Giovannoli* with the minimum purchase requirement disclosed by *Breen, Jr.* because this would eliminate dealings with customers who were unprofitable for a seller to deal with. Analysis of a customer’s past trade amounts would indicate to a seller a gross sales revenue to be compared to related costs of providing service to a

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customer. Those customers consistently causing a loss to a seller would of necessity be purged as unprofitable. Why would one sell to a customer who costs a seller money at each and every sale?

Concerning Claim 2, *Giovanni* discloses that sales-related information is selected from a potential purchaser at Col. 5, lines 15-18. In this instance, sales-related information is set by the seller to either be received by a purchaser or not received.

Concerning Claim 3, *Giovannoli* discloses the invention substantially as claimed. See the discussion of Claim 1 above. *Giovannoli* does not specifically disclose that purchaser registration information is updated based on a trade between a purchaser and a seller. Official Notice is taken that it was old and well known to update such information based on completed trades. For instance, the updating of accounts receivable from a purchaser upon a sale is fundamental to accounting practice for sales revenues. Establishing such receivables accounts would be essential an essential component of “registering” a purchaser. The Examiner makes this statement having been employed in accounting for nine years.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Giovannoli* to update purchaser registration/receivables information at sale because this would have maintained accurate and timely accounting records.

Concerning Claim 6, see the discussion of Claim 1 and *Giovannoli* further discloses “setting” of salable commodities for purchasers at Col. 7, lines 20-25 and lines 35-56.

As to Claim 7, *May* discloses updating of sales related information at Col. 23, lines 9-14. It would have been obvious to one of ordinary skill in the art at the time of the invention to

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modify *Giovannoli* with this feature because this would maintain information for trading in a most current state.

With respect to Claim 8, see the discussion of Claim 1 and *Giovannoli* further discloses registering purchasers according to instruction from seller at Col. 7, lines 20-25 and lines 35-56.

With respect to Claim 10, see the discussion of Claims 8 and 2.

As to Claim 11, see the discussion of Claim 8; *Giovannoli* further discloses a stored program executed by a computer to perform the method at Col. Col. 4, lines 4-52; recording trade amounts is old and well known in trading arts and would be obvious to maintain correct accounting records.

As to Claim 13, see the discussion of Claim 6 and *Giovannoli* further discloses a stored program executed by a computer to perform the method at Col. Col. 4, lines 4-52.

Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,842,178 *Giovannoli* in view of US 6,317,727 *May* and further in view of US 6,078,897 *Rubin et al.*

With respect to Claims 14-16, *Giovannoli* discloses the invention substantially as claimed. See the discussion of Claim 1 above. *Giovannoli* does not specifically disclose that a trade price is discounted based on a total trade amount for a past specific period. *Rubin* discloses this limitation at Col. 7, lines 17-22. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Giovannoli* to discount trade prices using a total trade amount for a past specific period because this would encourage purchasers remain loyal to a particular seller and to “buy more and save more”, as is frequently announced in advertising for

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sales offerings. The same reasoning applies to Claims 15 and 16 as to claim 14, as they are not further limiting.

Response to Arguments

Applicant's arguments with respect to claims 1, 2, 4, 6 and 8-13 have been considered; arguments still relevant after application of new art are addressed here.

The rejection of cancelled Claim 12 discussed at page 7 of the Remarks is withdrawn as moot.

At page 7 to page 8, first full paragraph of Remarks, Applicant generally argues that *May* teaches away from *Giovanolli* but provides not citation to the reference to support the contention. The references do differ but Applicant shows no reason why they would be antagonistic to one another. *Breen, Jr.* is now relied upon for the new limitation recited. Applicant's other arguments are similar to that discussed here.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles R Kyle whose telephone number is (703) 305-4458. The examiner can normally be reached on M-F 6:00-2:30.

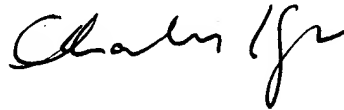
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

crk
June 20, 2005

Examiner Charles Kyle

A handwritten signature in black ink, appearing to read "Charles Kyle", with a stylized flourish at the end.